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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,438	07/19/2001	Gregg S. Homer	13007-1	2743
7590	12/24/2003		EXAMINER	
Stephen R. Seccombe Sheldon & Mak Suite 503 290 North "D" Street San Bernardino, CA 92401			ALAM, SHAHID AL	
			ART UNIT	PAPER NUMBER
			2172	
DATE MAILED: 12/24/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/910,438	HOMER, GREGG S.	
	Examiner Shahid Al Alam	Art Unit 2172	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 31 March 2003.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-61 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-7 and 9-61 is/are rejected.
- 7) Claim(s) 8 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
  - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

1. Claims 1 – 61 are pending in this Office action.

### ***Information Disclosure Statement***

2. The reference cited in the information disclosure statement (IDS) has been considered by the examiner.

### ***Priority***

3. This application is claiming the benefit of a prior filed nonprovisional application under 35 U.S.C. 120, 121, or 365(c).

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1 – 7, 9 – 11, 16, 18 – 21, 22 – 24, 31 – 37, 40, 42 – 47, 52 – 56 and 58 – 60 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent Number 5,926,624 issued to Donald R. Katz (hereinafter “Katz”).

With respect to claim 1, Katz teaches a system for facilitating distribution and accession of electronic files (see abstract and also column 8, lines 66 – 67, Katz teaches the step of querying), comprising:

a service facility (server) having an electronically accessible catalog of the electronic files, and a network interface (column 8, lines 8 – 10);  
means for transmitting the catalog to a customer (column 8, lines 8 – 12);

means for defining a customer account: for identifying a use and for processing a payment and for authorizing an access to the library (column 8, lines 19 – 24);

means for receiving a request from a customer (column 8, lines 17 – 18);

means for transmitting a selected file (column 8, line 11 "selected digital information"; column 5, lines 55 – 61); and

means for providing the customer with a player program (column 11, lines 1 – 31, specifically column 11, lines 16 – 19).

As to claim 2, transmitting only when the authorization remains established (column 8, lines 26 – 44 and column 9, lines 7 – 12).

As to claim 3, transmitting the catalog is connected to the network interface for receipt of the user request (column 8, lines 8 – 12 and 17 - 18).

As to claim 4, defining a user account is connected to the network interface (column 8, lines 26 – 44 and column 9, lines 7 – 12).

As to claim 5, setting an authorization level of the authorization to a first value corresponding to a first authorized plurality of the electronic files (column 8, 19 – 44).

As to claim 6, augmenting the authorization in accordance with further processing of payments by the customer (column 8, lines 8 – 18).

As to claim 7, defining the customer account comprises means for identifying existing file access software to be used by the customer, and wherein the player program is in the form of a software patch to be used in conjunction with the existing file access software (column 8, lines 19 – 24).

As to claims 9 and 23, encrypting the file and player program and decrypting while authorization remains established (column 8, lines 26 – 44 and column 9, lines 7 – 12).

As to claims 10 and 24, authorization is independent of the selected data file (column 8, lines 26 – 44 and column 9, lines 7 – 12).

As to claim 11, authorization is independent of the number of files selected (column 8, lines 26 – 44 and column 9, lines 7 – 12).

As to claim 16, authorization is for a collective number of accesses to data files (column 8, lines 26 – 44 and column 9, lines 7 – 12).

As to claims 9 – 11 and 16, Katz teaches the use of an authentication server in conjunction with library server. Upon receipt of a request from a user, Katz proves the user information obtained from the library server; the user information includes user content preference, and other usage information. The examiner assumes that the "usage" information as disclosed on column 8 includes the information as to how the data file and player can be used by the user at the client system.

The subject matters of claims 18 – 21 are rejected in the analysis above in claims 1 – 7 and these claims are rejected on that basis.

Claim 22 is essentially the same as claim 1 except that it recites a system for distributing and accessing. As to the step of accessing, Katz teaches the step of querying (Katz, column 8, lines 66 – 67). The remaining limitations of claim 22 can be found in the rejection of claim 1 above.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 12 – 15, 17, 25 – 30, 38, 39, 41, 48 – 51, 57 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz as applied to claims above, and further in view of U.S. Patent Number 5,953,005 issued to James Liu (hereinafter "Liu").

Claim 12 (authorization is for a period of time), claim 13 (period of time is calendar time), claim 14 and 15 (the period of time is measured when the player program accesses the file) and claim 17 (the number of accesses to a data file is counted only after a threshold period of time) further limit the subject matter of 10 and 11 such that the authorization is measured and monitored to limit the usage of media. Katz teaches encryption of information to be delivered and also teaches the use of keys to decrypt the received information (column 10, lines 19 – 21 and 45 – 47). Katz in addition teaches the limiting of playback of transmitted content (column 12, lines 24 – 26).

Katz however does not explicitly indicate the use of a "period of time" for monitoring the media usage. Liu teaches encryption of digitized data and valid usage lifetime of the encrypted data (see Liu, column 5, lines 23 – 25).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the "usage lifetime" of media content of Liu in Katz to enhance the monitoring of media content so that an user may use media content for unlimited amount of time. Limiting access based on time serves the commercial purpose of an information dissemination system. In other words, the "usage lifetime" of delivered information as taught by Liu can be utilized to bill a user based on the nature of access she or he desires. For instance, users who desire longer access pay more. The combination of Katz and Liu would be suitable for commercial and home users (Liu, col. 2, lines 11-14).

Claims 25 - 30 are rejected under the same rationale given above for claims 12 – 15 and 17. Claims 25 – 27 and 29 are directed to authorizing access for a period of time, activating a player program, monitoring the elapsed time, and inhibiting the operation of the player program and similar to claims 12 – 15.

Claim 28 is essentially the same as claims 12 - 15 except the time is calendar time. It would have been obvious to a person of ordinary skill to define a usage lifetime (see Liu, column 5, lines 23 – 25) based on a known standard. It would have been obvious to a person to rely on a built-in calendaring program to define the lifetime.

Claim 30 is directed to suppressing the inhibiting step until the end of currently accessed data file. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to suppress inhibiting for sake of contiguity of information. A sudden interruption of viewing would make a system unreliable. It would have been obvious to a person of ordinary skill to define a usage lifetime (see Liu,

column 5, lines 23 –25) long enough so that the interruption is avoided and thus make the system reliable.

Claims 31 – 41 are essentially the same as claims 1 – 30 except that it set forth the claimed invention as a system and method for distributing and playing electronic media rather than a system and method for facilitating distribution and accession of electronic files and rejected for the same reasons as applied to hereinabove.

Claims 42 – 51 are essentially the same as claims 1 – 30 except that it set forth the claimed invention as a method for distributing playing electronic media rather than a system and method for facilitating distribution and accession of electronic files and rejected for the same reasons as applied to hereinabove.

Claim 52 is essentially the same as claim 1 except that it sets forth the claimed invention as a system for distributing playing electronic media rather than a system for facilitating distribution and accession of electronic files and rejected for the same reasons as applied to hereinabove.

Claims 53 – 61 are essentially the same as claims 1 – 30 except that it set forth the claimed invention as a method for distributing electronic file to be accessed rather than a system and method for facilitating distribution and accession of electronic files and rejected for the same reasons as applied to hereinabove.

***Allowable Subject Matter***

8. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art does not teach or fairly suggests the means for identifying the existing file access software comprises means for electronically interrogating a computer being used by the user to determine a default media player setting of that computer, and wherein the means for providing the player program comprises selecting the software patch from a stored plurality of player patches.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahid Al Alam whose telephone number is (703) 305-2358. The examiner can normally be reached on Monday-Thursday 8:00 A.M. - 4:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry relating to the status of this application should be directed to the receptionist whose telephone number is (703) 305-3900.

  
Shahid Al Alam  
Primary Examiner  
Art Unit 2172